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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05/28/2008 and 08/06/2008*.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.
   4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-44* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The following is a Final Office Action in response to communications received May 28,
2008 and August 6, 2008. Claims 1, 4, 8, 9, 12, 16, 17, 20, 21, 22, 23, 24, 25, 28, 32, 35, 39, 43,
and 44 have been amended. Claims 1-44 remain pending and examined.

Response to Amendments

Applicant's amendment does not address all the rejections of the prior office action.
Applicant's arguments have been considered, but are not persuasive, as detailed in a separate
section later in this action. As to the objection made to the Abstract, Applicant's amendment
properly addresses this objection which is hereby withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-6, 8-14, 16-30, 32-37, and 39-44 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Morano et al. (Pub. No.: US 2004/0078271) in view of the publication on
July/August of 2003 of PriceWaterhouse Coopers (herein referred to as PWC) from the <u>Personal</u>

<u>Financial Services Newsletter</u> titled "Dividend and Capital Gain Changes under the Jobs and Growth Tax Relief Reconciliation Act (JGTRRA): Adding Complexity for Investors".

As to Claim 1, *Morano* teaches an automated computer-implemented apparatus for determining the dividend income of one or more investors for a selected time frame resulting from mutual fund dividend distributions made to accounts of the investors from one or more mutual funds (see at least Abstract, Figure 1, ¶[0001], ¶[0033], ¶[0034], ¶[0076], and ¶[0122]) the apparatus comprising:

(a) a first <u>electronic</u> database that stores account transaction history data of the investors for each of the mutual funds (see at least Figure 5 - items 550, 560, and 570, ¶[0001], ¶[0034], ¶[0038], ¶[0041], ¶[0060], and ¶[0063]);

(b) a second <u>electronic</u> database that stores dividend distribution information for each of the mutual funds and information indicating what percentage of dividend distributions of each of the mutual funds are QDI (see at least Figure 5 – items 500 and 510, ¶[0001], ¶[0034], ¶[0041], ¶[0060] through ¶[0063], ¶[0110], and ¶[0118]); and

(c) a QDI calculation engine which receives and processes the account transaction history data, the dividend distribution information, and the percentage of mutual fund dividend distributions that are QDI from the first and second <u>electronic</u> databases to automatically determine in a <u>computer</u> the personal QDI for a selected time frame for one or more of the investors, the account transaction history data being used to provide transaction data for a specific investor and to

determine whether holding period requirements are met for a specific investor (see at least Figure 1, Figure 5 – item 540, ¶[0001], ¶[0033], ¶[0034], ¶[0041], ¶[0043], ¶[0055], ¶[0056], ¶[0076] ¶[0080], ¶[0102], ¶[0107], ¶[0108], ¶[0110], and ¶[0118]) .

Morano does not specifically teach QDI or personal QDI. However, it was known in the art at the time of invention that calculation of the relevant dividend income would include QDI and relevant individual dividend income would include personal QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

Morano, also, does not specifically teach a calculation engine used to determine whether holding period requirements are met for a specific investor. However, it was known in the art at the time of invention that holding period would be included in the account transaction history data per *PWC* (see at least page 6, columns 2-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

As to Claim 2, Morano teaches a user interface for allowing an investor to communicate via a communication medium with the calculation engine to initiate a request for an individual dividend calculation to be performed for a selected time frame and for one or more selected accounts, wherein the calculation engine automatically performs the determination of the individual dividend income calculation for the one or more selected accounts upon receiving a

request from the user interface (see at least Figure 1, Figure 3, Background, ¶[0034], ¶[0040],

¶[0041], ¶[0047], ¶[0055], ¶[0056], ¶[0073], ¶[0083], and ¶[0118]).

  Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and relevant individual dividend income would include personal QDI per *PWC* (see at least page

6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the

art at the time of the invention to include such information for convenience to the customer in

minimizing their tax liability and complying with then current law.

  As to Claim 3, *Morano* teaches that the user interface is a web browser and the

communication medium is the Internet (see at least ¶[0035] and ¶[0036]).

  As to Claim 4, *Morano* teaches a third <u>electronic</u> database that stores account type

information for the accounts of the investors for each of the mutual funds, wherein the QDI

calculation engine receives the account type information from the third <u>electronic</u> database and

determines the personal QDI only for selected types of accounts (see at least Figure 1, Figure 5 –

item 530 and 540, ¶[0001], ¶[0033], ¶[0037], ¶[0038], ¶[0055], ¶[0063], ¶[0066], and ¶[0118]).

  Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and relevant individual dividend income would include personal QDI per *PWC* (see at least page

6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the

art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

As to Claim 5, *Morano* teaches that the dividend information includes dividend distribution frequency information (see at least ¶[0038], ¶[0062] – it is implicit that the frequency of dividend distribution would be included in this periodically updated information) and dividend amount per share information (see at least Figure 11, ¶[0038], ¶[0062], and ¶[0095]).

As to Claim 6, *Morano* teaches that the selected time frame is a calendar year (see at least ¶[0055], ¶[0073], ¶[0076] ¶[0080], ¶[0083], and ¶[0089]).

As to Claim 8, *Morano* teaches that the first <u>electronic</u> database and the second <u>electronic</u> database are subparts of the same <u>electronic</u> database (see at least Figure 1, ¶[0034], ¶[0038], ¶[0054], ¶[0063], and ¶[0118]).

Claim 9 is rejected for the same reasoning as Claim 1.

Claim 10 is rejected for the same reasoning as Claim 2.

Claim 11 is rejected for the same reasoning as Claim 3.

Claim 12 is rejected for the same reasoning as Claim 4.

Claim 13 is rejected for the same reasoning as Claim 5.

Claim 14 is rejected for the same reasoning as Claim 6.

Claim 16 is rejected for the same reasoning as Claim 8.

As to Claim 17, *Morano* teaches a computer-implemented method of automatically providing individual dividend income information to a mutual fund investor, the investor having one or more accounts in one or more mutual funds that declare dividend distributions (see at least Abstract, Background, Figure 5, ¶[0001], ¶[0033], ¶[0060], ¶[0064], ¶[0066], ¶[0095] and ¶[0108]), the method comprising:

(a) an investor inputting via a user interface (see at least Figure 1, Figure 2, ¶[0034], ¶[0040], and ¶[0073]):

(i) an indication of which accounts the individual dividend income information is desired (see at least Figure 9 – item 910, Figure 10, Figure 11, ¶[0055], ¶[0073], and ¶[0076]), and

(ii) a time frame for which the individual dividend income information is desired (see at least Figure 9 – item 910, Figure 10, Figure 11, ¶[0055], ¶[0073], and ¶[0076]);

(b) providing a first electronic database that stores account transaction history data of the mutual fund investor for each of the mutual funds held by the investor, and a second electronic database that stores dividend distribution information for each of the mutual funds held by the investor and information indicating what percentage of dividend distributions of each of the mutual funds held by the investor are QDI (see at least Figure 1, Figure 5 – item 540, ¶[0001], ¶[0033],

¶[0034], ¶[0038], ¶[0041], ¶[0043], ¶[0055], ¶[0056], ¶[0062], ¶[0076] ¶[0080],

¶[0095], ¶[0102], ¶[0110], and ¶[0118]);

(c) automatically determining <u>in a computer</u> the personal QDI for the indicated

accounts and time frame by using a QDI calculation engine which receives and

processes the investor inputs, the account transaction history data, the dividend

distribution information, and the percentage of mutual fund dividend distributions

that are QDI from the first and second <u>electronic</u> databases, the account

transaction history data being used to provide transaction data for an investor and

to determine whether holding period requirements are met for a specific investor

(see at least Figure 1, Figure 5 – item 540, ¶[0001], ¶[0033], ¶[0034], ¶[0041],

¶[0043], ¶[0055], ¶[0056], ¶[0076] ¶[0080], ¶[0095], ¶[0102], ¶[0107], ¶0108],

¶[0110], and ¶[0118]); and

(d) automatically providing individual dividend income information for the

investor from the determined individual dividend income (see at least Figure 5,

¶[0062], ¶[0095], ¶[0099], ¶[0108], and ¶[0118]).

Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and relevant individual dividend income would include personal QDI per *PWC* (see at least page

6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the

art at the time of the invention to include such information for convenience to the customer in

minimizing their tax liability and complying with then current law.

Morano, also, does not specifically teach a calculation engine used to determine whether holding period requirements are met for a specific investor. However, it was known in the art at the time of invention that holding period would be included in the account transaction history data per *PWC* (see at least page 6, columns 2-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

As to Claim 18, *Morano* teaches the inputted time frame is a previous year's income (see at least ¶[0046], ¶[0055], ¶[0073], ¶[0076] ¶[0080], ¶[0083], and ¶[0089] it is implicit that the user can input the time frame of the previous year), and the individual dividend income information includes for each account:

(i) total ordinary dividends from Form 1099-DIV for the previous year (see at least ¶[0046], ¶[0055], ¶[0064], ¶[0073], ¶[0076] through ¶[0078], ¶[0080], ¶[0081], ¶[0083], ¶[0089] - it is implicit that the user can input the time frame of the previous year and the corresponding information on the Form 1099-DIV),

(ii) qualified dividends from Form 1099-DIV for the previous year (see at least ¶[0046], ¶[0055], ¶[0064], ¶[0073], ¶[0076] through ¶[0078], ¶[0080], ¶[0081], ¶[0083], ¶[0089] - it is implicit that the user can input the time frame of the previous year and the corresponding information on the Form 1099-DIV), and

(iii) individual dividend income amount for the previous year (see at least ¶[0046], ¶[0055], ¶[0064], ¶[0073], ¶[0076] through ¶[0078], ¶[0080], ¶[0081],

¶[0083], ¶[0089] - it is implicit that the user can input the time frame of the previous year and the corresponding information on the Form 1099-DIV).

Morano does not specifically teach QDI or personal QDI. However, it was known in the art at the time of invention that calculation of the relevant dividend income would include QDI and personal QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

As to Claim 19, *Morano* teaches the inputted time frame is an inputted number of days for the current year, and the individual dividend income information includes for each account (see at least Figure 7 through Figure 11, ¶[0002] through ¶[0004], ¶[0046], ¶[0061] through ¶[0065], and ¶[0107] – it is implicit that the updating process would result in the inputted time frame to include an inputted number of days):

(i) total ordinary dividends paid to date for the current year (see at least Figure 7 through Figure 11, ¶[0002] through ¶[0004], ¶[0046], ¶[0061] through ¶[0065], ¶[0095], and ¶[0107] – it is implicit that the updating process would ultimately provide total ordinary dividends paid to date for the current year), and

(ii) estimated individual dividend income amount to date for the current year (see at least Figure 7 through Figure 11, ¶[0002] through ¶[0004], ¶[0046], ¶[0061] through ¶[0065], ¶[0095], and ¶[0107] – it is implicit that the updating process

would ultimately provide estimated individual dividend income amount to date

for the current year).

Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and personal QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would

have been obvious to one of ordinary skill in the art at the time of the invention to include such

information for convenience to the customer in minimizing their tax liability and complying with

then current law.

As to Claim 20, *Morano* teaches a third <u>electronic</u> database that stores account type

information for the accounts of the investors for each of the mutual funds, wherein the QDI

calculation engine receives the account type information from the third <u>electronic</u> database, the

account type information being used to indicate on the user interface which accounts are eligible

for the personal QDI information (see at least Figure 1, Figure 5 – item 530 and 540, ¶[0001],

¶[0033], ¶[0037], ¶[0038], ¶[0055], ¶[0063], ¶[0066], and ¶[0118]).

Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and personal QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would

have been obvious to one of ordinary skill in the art at the time of the invention to include such

information for convenience to the customer in minimizing their tax liability and complying with

then current law.

As to Claim 21, *Morano* teaches that the first <u>electronic</u> database and the second <u>electronic</u> database are subparts of the same <u>electronic</u> database (see at least Figure 1, ¶[0034], ¶[0038], ¶[0054], ¶[0063], and ¶[0118]).

As to Claim 22, *Morano* teaches a computer-implemented method of automatically generating individual dividend income information for selected mutual fund investors, each investor having one or more accounts in one or more mutual funds that declare dividend distributions, the method comprising (see at least Abstract, ¶[0001], ¶[0033], ¶[0034], ¶[0037], ¶[0038], ¶[0054], ¶[0055], ¶[0062], ¶[0063], ¶[0083], and ¶[0118]):

(a) automatically identifying in <u>a</u> computer mutual fund investors who are recipients of a Form 1099-DIV for at least one mutual fund, the Form 1099-DIV including the QDI for each of the mutual funds that are eligible for QDI (see at least Figures 9 through 11, Abstract, ¶[0001], ¶[0033], ¶[0034], ¶[0060], ¶[0062] through ¶[0066], ¶[0076], ¶[0094], ¶[0095], ¶[0107], ¶[0111], ¶[0115], and ¶[0118]);

(b) automatically performing <u>in the computer</u> a personal QDI calculation for each of the recipients (see at least Figures 9 through 11, Abstract, ¶[0001], ¶[0033], ¶[0055], ¶[0056], ¶[0064], ¶[0107], and ¶[0118]);

(c) automatically comparing <u>in the computer</u> the personal QDI and the QDI on the Form 1099DIV (see at least Figures 9 through 11, Abstract, ¶[0001], ¶[0033], ¶[0055], ¶[0056], ¶[0064], ¶[0095], ¶[0107], and ¶[0118]); and

(d) generating personal QDI information in the computer for only the mutual fund

investors that have personal QDI that is less than the QDI on the Form 1099-DIV

(see at least Figures 9 through 11, Abstract, ¶[0001], ¶[0033], ¶[0034], ¶[0040],

¶[0055], ¶[0056], ¶[0064], ¶[0095], ¶[0107], and ¶[0118]).

Morano does not specifically teach QDI or personal QDI. However, it was known in the

art at the time of invention that calculation of the relevant dividend income would include QDI

and relevant individual dividend income would include personal QDI per PWC (see at least page

6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the

art at the time of the invention to include such information for convenience to the customer in

minimizing their tax liability and complying with then current law.

As to Claim 23, Morano teaches:

(i) providing a first electronic database that stores account transaction history data

of the mutual fund investors for each of the mutual funds (see at least Figure 1,

Figure 5 - items 550, 560, and 570, ¶[0001], ¶[0034], ¶[0038], ¶[0041], ¶[0060],

¶[0063], and ¶[0118]);

(ii) providing a second electronic database that stores dividend distribution

information for each of the mutual funds and information indicating what

percentage of dividend distributions of each of the mutual funds are QDI (see at

least Figure 5 – items 500 and 510, ¶[0001], ¶[0034], ¶[0041], ¶[0060] through

¶[0063], ¶[0110], and ¶[0118]); and

(iii) automatically determining <u>in the computer</u> the personal QDI for a selected time frame for each of the recipients using a QDI calculation engine which receives and processes the account transaction history data, the dividend distribution information, and the percentage of mutual fund dividend distributions that are QDI from the first and second <u>electronic</u> databases, the account transaction history data being used to provide transaction data for a specific recipient and to determine whether holding period requirements are met for a specific recipient (see at least Figure 1, Figure 5 – item 540, ¶[0001], ¶[0033], ¶[0034], ¶[0041], ¶[0043], ¶[0055], ¶[0056], ¶[0076] ¶[0080], ¶[0102], ¶[0107], ¶[0108], ¶[0110], and ¶[0118]).

Morano does not specifically teach QDI or personal QDI. However, it was known in the art at the time of invention that calculation of the relevant dividend income would include QDI and relevant individual dividend income would include personal QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

Morano, also, does not specifically teach a calculation engine used to determine whether holding period requirements are met for a specific investor. However, it was known in the art at the time of invention that holding period would be included in the account transaction history data per *PWC* (see at least page 6, columns 2-3). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

As to Claim 24, *Morano* teaches that the first <u>electronic</u> database and the second <u>electronic</u> database are subparts of the same <u>electronic</u> database (see at least Figure 1, ¶[0034], ¶[0038], ¶[0054], ¶[0063], and ¶[0118]).

Claim 25 is rejected for the same reasoning as Claim 1.

Claim 26 is rejected for the same reasoning as Claim 2.

Claim 27 is rejected for the same reasoning as Claim 3.

Claim 28 is rejected for the same reasoning as Claim 4.

Claim 29 is rejected for the same reasoning as Claim 5.

Claim 30 is rejected for the same reasoning as Claim 6.

Claim 32 is rejected for the same reasoning as Claim 9.

Claim 33 is rejected for the same reasoning as Claim 10.

Claim 34 is rejected for the same reasoning as Claim 11.

Claim 35 is rejected for the same reasoning as Claim 12.

Claim 36 is rejected for the same reasoning as Claim 13.

Claim 37 is rejected for the same reasoning as Claim 14.

Claim 39 is rejected for the same reasoning as Claim 17.

Claim 40 is rejected for the same reasoning as Claim 18.

Claim 41 is rejected for the same reasoning as Claim 19.

Claim 42 is rejected for the same reasoning as Claim 20.

Claim 43 is rejected for the same reasoning as Claim 22.

Claim 44 is rejected for the same reasoning as Claim 23.

Claims 7, 15, 31, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morano et al. (Pub. No.: US 2004/0078271) in view of PWC, and further in view of Peterson et al. (Pat. No.: US 7,016,873).

As to Claim 7, while *Morano* discloses a calculation engine (see at least Figure 1, ¶[0034], and ¶[0041]), it does not specifically disclose that the calculation engine uses a first in first out (FIFO) redemption methodology to make the holding period determination. However, it was well know to one of ordinary skill in the art to use a first in first out (FIFO) redemption methodology to make the holding period determination. *Peterson* discloses using a first in first out (FIFO) redemption methodology to make the holding period determination (see at least Col. 3, lines 62-67 and Col. 4, lines 1-9).

Morano does not specifically teach QDI. However, it was known in the art at the time of invention that calculation of the relevant dividend income would include QDI per *PWC* (see at least page 6, columns 2-3, and page 7, column 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to include such information for convenience to the customer in minimizing their tax liability and complying with then current law.

Claim 15 is rejected for the same reasoning as Claim 7.

Claim 31 is rejected for the same reasoning as Claim 7.

Claim 38 is rejected for the same reasoning as Claim 15.

Response to Arguments

Applicant's arguments with respect to the rejection of Claims 1-44 filed August 8, 2008 have been fully considered but are not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regards to applicant's arguments over the patentability of independent claims 1, 9, 17, 22, 25, 32, 39, and 43, applicant argues against the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although PWC states

that doing personal QDI calculations "may prove challenging", the concept of calculating and

reporting personal QDI is disclosed by PWC (see at least Pages 6 and 7).

Applicant's assertion that Moreno in view of PWC fails to teach the features disclosed in

Claims 22 and 43, has also been fully considered and found unpersuasive. Examiner respectfully

maintains the rejection for Claims 22 and 43. In response to applicant's argument that the

examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

upon hindsight reasoning. But so long as it takes into account only knowledge which was within

the level of ordinary skill at the time the claimed invention was made, and does not include

knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In*

re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's arguments that the dependent claims are believed to be allowable because

they depend upon respective allowable independent claims and recite additional patentable steps,

fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims

define a patentable invention without specifically pointing out how the language of the claims

patentably distinguishes them from the references.

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of

the extension of time policy as set forth in 37CFR 1 .I 36(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the date of this final

action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to IRENE KANG whose telephone number is (571)270-3611. The

examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Kramer can be reached on (571)272-6783. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

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